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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Timothy W. Genske

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EXAMINER

LIN, KELVIN Y

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,811

Applicant(s)

GENSKE ET AL.

Examiner

Kelvin Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Reopening of Prosecution After Appeal Brief or Reply Brief

In view of the appeal brief filed on 3/13/06, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 51-67 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of copending Genske et al., (US Application No. 09660531, thereafter is referred as Genske531). Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between two sets of claims is "executing said commands transmitted to the host device on the host device" and "in response to said commands transmitted to the host device, returning a reply from the host device to the first device", respectively, which as in the claims 24 and 36 of the reference Genske531 perform the same function. In re Karlson, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Therefore, it would have been obvious to ordinary skill in the art at the time of invention in the computer-networking environment that variations of initiating a dialog between the two devices at the host device is well-known in client-server configuration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-26, 30, 32, 34, 36-39, 40 are rejected under 35 USC 102(e) as being anticipated by Robinson et al., (USPN 6442625).
2. Regarding claim 1, Robinson teaches a computer environment where devices are occasionally connected together, a method for automated transmission and execution of an executable file of interest originating from a digital camera, upon the digital camera's connection to a cellular phone, the method comprising:
 - connecting the digital camera to a cellular phone capable of hosting the camera (Robinson, Fig. 5a, col.9, l.4-8, the cellular phone is recognized the command and dials number to remote location to transmit the stored photo data upon the completion of the communication link);
 - identifying at least one particular cellular phone that is connected to the camera, including determining communication information allowing communication between the camera and the particular cellular phone, and determining command information allowing the camera to invoke execution of a file of interest at the particular cellular phone (Robinson, col. 6, l.39-55, if the module is to be used with a cellular phone, the flash memory be a GSM interface compatible format, and be adaptable so as to be readable and transmittable by a particular manufacture's model of a

cellular phone);

- based on said determined communication information, transmitting the executable file of interest from said camera to the particular cellular phone (Robinson, col. 6, l.56- col.7, l.4,col.9, l.2-4, the digital camera system incorporating a flash with user input command to provide the information to cellular phone and instruct the cellular phone transmit the data to remote location); and
 - based on said determined command information, invoking execution of the executable file of interest after it has been transmitted to the particular cellular phone (Robinson, col. 7, l.1-4, provides the information to the cellular phone to instruction the cellular phone to dial a preselected telephone number and then transmit the data to the remote location);
3. Regarding claim 2, Robinson further discloses the method of claim 1, wherein Said executable file of interest comprises a driver file (Robinson, col.6, l.65-col.7, l.4, to dial a preselected telephone number and transmit the data to remote location is a communication stack software corresponding to a driver file).
4. Regarding claim 3, Robinson further discloses the method of claim 2, wherein said Driver file, upon execution, controls operation of said camera (Robinson, col.9, l.1-7).
5. Regarding claim 4, Robinson further discloses the method of claim 1, wherein

said Executable file comprises one of a machine instruction for a target processor and a Java bytecode instruction for a Java virtual machine (Robinson, col.9, l.1-7, the GSM packet contains the command file of the bytecode serve the same purpose of java code).

6. Regarding claim 5, Robinson further discloses the method of claim 1, wherein said executable file comprise an application program capable of executing at said cellular phone (Robinson, col.9, l.1-7, the GSM packet contains the command file for transmitting the photo to remote location).
7. Regarding claim 6, Robinson further discloses the method of claim 1, wherein said camera includes an add-in device capable of being hosted by said cellular phone (Robinson, col. 7, l.30-34, module 501 can be dismounted from camera and remounted to camera for the new photo).
8. Regarding claim 7, Robinson further discloses the method of claim 6, wherein said Camera comprises a digital camera and wherein said method further comprises: Upon execution of said executable file at said cellular phone, transferring image information from said digital camera to said cellular phone (Robinson, col. 6, l.39-55).
9. Regarding claim 8, Robinson further discloses the method of claim 7, further comprises: after transferring said image information from said digital camera to said cellular phone, wirelessly transmitting said image information to a third device (Robinson, col. 6, l.56- col.7, l.4,col.9, l.2-4, the digital camera system incorporating a flash with user input command to provide the information

to cellular phone and instruct the cellular phone transmit the data to remote location).

10. Regarding claim 9, Robinson further discloses the method of claim 1, wherein said cellular phone includes a computing device capable of hosting other devices (Robinson, col.7, l.40-49).
11. Regarding claim 10, Robinson further discloses the method of claim 1, wherein said cellular phone includes wireless transmission capability for transferring information received from said camera to other devices (Robinson, col. 6, l.56-col.7, l.4,col.9, l.2-4, the digital camera system incorporating a flash with user input command to provide the information to cellular phone and instruct the cellular phone transmit the data to remote location).
12. Regarding claim 11, Robinson further discloses the method of claim 1, wherein said camera and cellular phones are occasionally connected together. (Robinson, Fig. 5a).
13. Regarding claim 12, Robinson further discloses the method of claim 1, wherein said camera and cellular phones are permanently connected together (Robinson, Fig. 5a).
14. Regarding claim 13, Robinson further discloses the method of claim 1, wherein said camera and cellular phones are connected together via a serial communication link (Robinson, fig. 5a)
15. Regarding claim 14, Robinson further discloses the method of claim 1, wherein

said camera and cellular phones are connected together via a USB (Universal Serial Bus) (Robinson, fig. 5a)

16. Regarding claim 15, Robinson further discloses the method of claim 1, wherein said camera and cellular phones are connected together via a USB (Universal Serial Bus) (Robinson, fig. 5a)
17. Regarding claim 16, Robinson further discloses the method of claim 1, wherein Invocation of said identifying step occurs upon connecting said camera and cellular phones together (Robinson, col. 6, l.39-55)
18. Regarding claim 17, Robinson further discloses the method of claim 1, wherein Said identifying step includes: probing the camera's environment for determining which devices, if any, the camera is attached to (Robinson, col. 6, l.47-51).
19. Regarding claim 18, Robinson further discloses the method of claim 17, wherein Said probing step includes: determining a default communication medium for probing for new devices (Robinson, col. 6, l.47-51).
20. Regarding claim 19, Robinson further discloses the method of claim 18, wherein Said default communication medium is specified initially by factory-preset Information (Robinson, col.5, l.60-67).
21. Regarding claim 20, Robinson further discloses the method of claim 18, wherein Said default communication medium is a selected one of a wireless and a wired communication medium (Robinson, col. 7, l.1-4, to instruct the cellular phone to dial a preselected telephone number corresponding to the wireless and a wired

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communication medium).

22. Regarding claim 21, Robinson further discloses the method of claim 20, wherein said default communication medium includes a serial (RS-232) and a USB (Universal Serial Bus) wired communication medium (Robinson, fig. 5a, a serial communication link to cellular phone)
23. Regarding claim 22, Robinson further discloses the method of claim 19, wherein said factory-preset information is stored in a registry of the camera (Robinson, col.3, l.33-36, the flash memory of camera to download information to a cellular phone corresponding to the factory preset information is stored in a registry of camera).
24. Regarding claim 23, Robinson further discloses the method of claim 19, wherein Said factory-preset information includes a default communication rate and default handshake protocol for at least one potential cellular phone (Robinson, col. 4, l.30-35, the GSM is a wireless protocol includes the communication rate and handshake protocol).
25. Regarding claim 24, Robinson further discloses the method of claim 17, wherein Said probing step includes: executing an initial sequence of handshake commands and comparing any response received to a list of known response for identifying a particular cellular phone (Robinson, col. 4, l.30-35, the GSM is a wireless protocol includes the handshake procedure and identifying the preselected telephone number).
26. Regarding claim 25, Robinson further discloses the method of claim 17, wherein

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- Said probing step continues until all know potential cellular phone have been enumerated. (Robinson, col. 4, l.30-35, the GSM is a wireless protocol includes the handshake procedure and identifying the preselected telephone number).
27. Regarding claim 26, Robinson further discloses the method of claim 1, wherein Said identifying step includes: updating a registry at said camera for indicating any connected cellular phone that has been identified (Robinson, col. 24, l.17-21).
28. Regarding claim 30, Robinson further discloses the method of claim 1, wherein said step of transmitting the executable file of interest includes: opening the executable file of interest at the camera; and streaming the opening executable file of interest from the camera to the cellular phone (Robinson, col.9, l.1-8).
29. Regarding claim 32, Donner further discloses the method of claim 30, wherein said step of transmitting further comprises: returning to said camera a file handle permitting said camera to access said executable file of interest transmitted to said cellular phone (Robinson, col.6, l.30-38).
30. Regarding claim 34, Robinson further discloses the method of claim 1, wherein Said executable file in interest comprises a byte-code program, and wherein said cellular phone includes capability for executing byte-code program (Robinson, col.9, l.1-7, the GSM packet contains the command file of the bytecode).
31. Regarding claim 36, Robinson further discloses the method of claim 1, wherein Said step of invoking execution of the executable file of interest includes: Issuing a command from said camera to said cellular phone to begin execution at

said cellular phone of said executable file of interest (Robinson, col.7, l.15-49).

32. Regarding claim 37, Robinson further discloses the method of claim 1, wherein Said step of invoking execution of the executable file of interest includes: triggering execution of said executable file indirectly at said cellular phone by instructing said cellular phone to restart itself (Robinson, col.6, l.30-38).
33. Regarding claim 38, Robinson further discloses the method of claim 1, wherein further comprising: placing said camera in a listing mode, after said camera has invoked execution of said executable file at said cellular phone (Robinson, col. 4, l.30-35, the GSM is a wireless protocol includes the polling period corresponding to listening mode).
34. Regarding claim 39, Robinson further discloses the method of claim 38, wherein Said camera awaits commands from said cellular phone, while said camera is in a listing mode (Robinson, col. 4, l.30-35, the GSM is a wireless protocol includes the polling period corresponding to awaits command).
35. Regarding claim 40, Robinson further discloses the method of claim 39, wherein commands received at said camera from said cellular phone control operation of said camera (Robinson, fig. 5b, col. 8, l.11-31)
36. Claims 41-50, claiming for multi-device providing automated loading have limitation corresponding to method claims 1-2, 4, 6, 8, 31, 34-35. Therefore claim 41-50 are rejected under Robinson's for the same reason set forth in the rejection of claims 1-2, 4, 6, 8, 31, 34-35.

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37. Claims 51-67 have limitation corresponding to method claims 1-2, 4, 6, 8, 31-32, 34-35, 38-39. The differences are "the digital camera" is replaced by "the first device" and the "cellular phone" replace by "host device". Therefore claim 51-67 are rejected under Robinson's for the same reason set forth in the rejection of claims 1-2, 4, 6, 8, 31-32, 34-35, 38-39.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

38. Claims 27-29, 31,33, 35, 68-87 are rejected under 35 USC 103(a) as being unpatentable over Robinson in view of Donner et al., (PGPUB 2006/0173781).
39. Regarding claim 27, Robinson does not specifically disclosed TCP/IP communication between cellular phone and camera.
- However, Donner discloses the method of claim 1, further comprising: upon identifying at least one particular cellular phone, ensuring that a state of TCP/IP communication is reached between said camera and the

particular identified cellular phone (Donner, [0222], IP over Bluetooth can support TCP/IP, [0263], with the Bluetooth enabled cellular phone it can communicate with the digital camera).

Because knowing that Donner constructs the 3G GSM, WAP having greater bandwidth rate and supports multimedia transmission for cellular phone and digital camera, it would have been obvious to use the high performance and unify wireless protocol incorporating with Robinson's structure to improve the transmission rate. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention.

40. Regarding claim 28, Donner discloses the method of claim 27, wherein said step of ensuring that a state TCP/IP communication is reach includes: initiating a PPP (point-point protocol) communication session between said camera and cellular pone, and thereafter, initiating TCP/IP communication session between said camera and cellular phones (Donner, [0222], IP over Bluetooth can support TCP/IP, [0263], with the Bluetooth enabled cellular phone it can communicate with the digital camera).
41. Regarding claim 29, Donner further discloses the method of claim 27, wherein said step of ensuring that a state TCP/IP communication is reached includes: determining an IP (Internet Protocol) address for said cellular phone (Donner, [0156]).
42. Regarding claim 31, Donner further discloses the method of claim 30, wherein Said streaming step includes: employing XML protocol for packing said

- executable file of interest for delivery to the cellular phone. (Donner, [0188]).
43. Regarding claim 33, Donner further discloses the method of claim 31, wherein said file handle comprises a file handle that may be understood by said cellular phone for accessing a particular file of interest at said cellular phone (Donner, [0188]).
44. Regarding claim 35, Donner further discloses the method of claim 1, wherein said executable file of interest comprises a Java program, and wherein said cellular phone includes a Java Virtual Machine for executing Java Programs (Donner, [0167]).
45. Claims 68-87 are rejected under 35 USC 103(a) as being unpatentable over Robinson in view of Donner et al., and further in view of Zintel et al., (USPAT 6910068).
46. Regarding Claims 68-87 Donner only discloses the XML is used for device communication (Donner, [0188]), but, Donner does not specifically disclose the XML syntax. However Zintel discloses the XML-based Upnp device (Zintel, Abstract, and fig. 45-51) which Donner is mentioned in [0188], it would have been obvious to use the XML syntax of Zintel in the device of Donner. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

09/08/06
KYL



ANDREW CALDWELL
PATENT EXAMINER